

Curry et al.

Page 7

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REMARKS

The Board of Patent Appeals and Interferences (BPAI) issued a decision as to Applicant's appeal on March 13, 2007. In this decision, the BPAI sustained the Examiner's rejection of the claims under 35 USC 102(b) as to Budge (6,564,248). The BPAI promulgated a claim construction of the pending claims, especially claim 1, that was at odds with how Applicant (and presumably the Examiner) had been interpreting the claims throughout prosecution. In particular, Applicant had submitted that the proper way to interpret the claims is that there is a first client having a first email messaging program installed thereon, and a composing user composes a message and records media on this first email messaging program. By comparison, the BPAI believed that the claims were somewhat vague in this respect, and could be interpreted to include the interpretation that the composing user composes the message and records the media *on the first client* itself, irrespective of whether or not such message composing and media recording are done on the first email messaging program. Insofar as Budge teaches this broader interpretation of the claim language, the BPAI sustained the Examiner's rejection.

Therefore, in this preliminary amendment, Applicant has amended the claim language to make it explicitly clear that the composing user composes the message and records the media *on the first email messaging program* in particular, and not just on the client in general. This amendment is made consistent with how Applicant had been interpreting the claims all along. Therefore, as to the amended claims, Applicant submits that Budge does not teach, disclose, or suggest all the claim limitations. In particular, as discussed in detail throughout prosecution and appeal – see, for example, the office action response of November 20, 2003, the contents of which are omitted herein to avoid redundancy – Budge does not teach a composing user both composing a message and recording media *on a first email messaging program*. While Budge may teach a composing user both composing a message and recording media *on a client*, this is not what the claims are explicitly limited to now.

Applicant notes that this position is not contrary to BPAI's decision of March 13, 2007. As described above, the BPAI interpreted the claim language (prior to amendment in this preliminary amendment) as more broadly being limited to a composing user composing a message and recording media on a *client*. The BPAI did not have to consider, and indeed did not consider, whether Budge teaches the more limited claim language, to which the claimed invention is now explicitly limited, as to a composing user composing a message and recording media on an *email messaging program* of a client. Therefore, the amendment of the claims made herein is intended to focus the invention so that the claim language explicitly corresponds with how Applicant had been interpreting the claims all along. Insofar as Budge does not teach a composing user both composing a message and recording media on an email messaging program, as discussed in the office action response of November 20, 2003, for instance, Budge does not anticipate the claimed invention as has been amended.

Applicant has therefore made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael Dryja, Applicant's Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Michael Dryja", written over a horizontal line.

Michael Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

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Date

Michael Dryja, Esq.
Law Offices of Michael Dryja
704 228th Ave NE #694
Sammamish, WA 98074

tel: 425-427-5094
fax: 425-563-2098